

REMARKS/ARGUMENTS

This paper is responsive to the Office Action mailed April 9, 2010. Claims 1, 2, 4, 5, 9-18, 20, and 24-31 were pending before submission of this paper. Claims 1, 2, 4, 5, 9-18, 20, and 24-31 were rejected. Specifically, claims 1, 2, 4, 5, 9-18, 20, and 24-31 were rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement. Claim 1 was rejected under 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 1, 2, 4, 5, 9-18, 20, and 24-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thrall (US 2005/0120311 A1) (hereinafter “Thrall”) in view of Cheung *et al.* (US 7,076,479 B1) (hereinafter “Cheung”). While applicant respectfully disagrees with the rejection, in order to advance the prosecution of the present application Claims 1, 13, and 24 have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

I. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 Comply With 35 U.S.C. § 112, First Paragraph

As indicated above, claims 1, 2, 4, 5, 9-18, 20, and 24-31 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action alleged that the specification does not disclose the recitation in Claim 1 of “the determining being independent of a page number of the search results in which the link for the item is configured to be displayed, wherein said search results had to be provided to a consumer computer system different from said one or more computer systems, and wherein the link for the item is distinct from the advertisement for the item.” Independent Claims 13 and 24 were rejected for the same reason.

While applicant respectfully disagrees with the rejection, in order to advance the prosecution of the present application Claims 1, 13, and 24 have been amended to further clarify the features cited in the Office Action as allegedly lacking support in the specification. Applicant respectfully submits that, contrary to the Office Action assertions, support for the

amendments is found, among other places, in paragraph [0003], lines 2-4, paragraph [0016], lines 2-6, paragraph [0018], lines 7-13, paragraph [0038], lines 5-10, and Claims 1-3 of the application as filed. Thus, applicant respectfully submits that Claims 1, 13, and 24, as amended, comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Applicant respectfully requests that the rejection of Claims 1, 13, and 24, and dependent claims be withdrawn.

II. Claim 1 Complies With 35 U.S.C. § 112, Second Paragraph

As indicated above, Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. To address the Section 112, second paragraph issues contained in the Office Action, applicant has amended Claim 1 to provide proper antecedent basis for the terms “item,” “link,” and “term,” thus ensuring proper relationship between those items. As a result, applicant respectfully submits that Claim 1, as amended, complies with the requirements of 35 U.S.C. § 112 second paragraph, and requests that the rejection be withdrawn.

III. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 Are Allowable Under 35 U.S.C. § 103 Over Thrall in View of Cheung et al.

As indicated above, Claims 1, 2, 4, 5, 9-18, 20 and 24-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thrall in view of Cheung et al. While applicant disagrees with the rejection, in order to advance the prosecution of the current application, independent Claims 1, 13, and 24 have been amended.

A. Independent Claim 1

Independent Claim 1 in part, as amended, recites:

1. A computer-implemented method for determining when to place an advertisement for an item on a first page of search

results for a search request related to the item, the method comprising:

upon receiving a new search request containing at least a search term that is associated with the item and was included in the search results relating to previously-executed searches,

determining an extent relating the at least a search term to the item, the extent being a function of at least a frequency of selection of the link to information for the item when the link was displayed on at least one of a plurality of pages of the corresponding search results, and a page number on which the selected link was presented, the extent being greater for a higher page number at the same frequency of selection;

if the extent relating the at least a search term to the item exceeds extents calculated for other items related to the at least a search term in the new search request, determining to place an advertisement for the item on a first page of search results for the new search request; and

providing the search results and the advertisement to a consumer computer system different from said one or more computer systems, the search results for the new search request being distinct from the advertisement for the item.

Applicant respectfully submits that Claim 1, as amended, is allowable over Thrall, taken alone or in combination with Cheung. In particular, applicant respectfully submits that Thrall, alone or in combination with Cheung, at a minimum fails to teach or suggest each of the element listed above recited in claim 1.

Thrall does not describe or suggest “determining to place an advertisement for the item on a first page of search results for the new search request, … the search results for the new search request being distinct from the advertisement for the item” as recited in amended Claim 1. In fact, Thrall does not disclose placing an advertisement at all. The Office Action asserts, with respect to Claim 1: “Thrall teaches that relevant images buried in search results tend to migrate upwards in the future search results. In this case the relevant images (advertisement) which migrates upwards (first page) is distinct from the links that were buried in the previous search result.” However, Thrall does not describe “search results … being distinct from the advertisement.” Paragraph [0010] of Thrall, referenced in the Office Action, states: “The described embodiment determines a user preference score for each image that is clicked for a given query. The score tends to favor images that are not located in proper physical positions in the search results (such as images not on page one) and further tends to favor images that receive a large number of clicks.” It does not follow from the referenced text that, first, the relevant images may be equated to advertisements, and, second, the migrating upwards may be equated to “plac[ing] an advertisement for the item on a first page of search results.” Indeed, nowhere does Thrall describe or suggest placing advertisements, much less “determining to place an advertisement for the item on a first page of search results for the new search request, … the search results for the new search request being distinct from the advertisement for the item” as recited in amended Claim 1.

Chueng does not provide the elements missing in Thrall. Applicant respectfully submits that the Office Action misinterpreted Cheung in the rejection of Claim 1. The Office Action asserts that Cheung allegedly “teaches advertiser bidding for placement of advertisement and the advertiser’s listing displayed separately from the list of search results or even in separate web browser windows,” referencing Column 7, lines 3-25 of Cheung. Applicant respectfully disagrees. The referenced text of Cheung discloses, *inter alia*:

“In addition, the search result list of the present invention is preferably combined with “non-paid” website descriptions generated by a conventional Internet search engine, preferably including listings

generated according to mathematics-based database search algorithms as discussed above. The combination of paid and unpaid listings helps ensure that the searcher will receive the most complete and relevant search results. Most preferably, the non-paid listings are considered to have a bid amount of zero and are therefore underneath the paid results.”

As shown above, nowhere does this section of Cheung describe or suggest “the search results for the new search request being distinct from the advertisement for the item” as recited in amended Claim 1.

Accordingly, even if the combination of Thrall and Cheung were possible, which applicant categorically denies, such proposed combination would at best result in displaying search results in a particular order depending on the score, underneath paid search results. In summary, none of the references, alone or in combination, teaches or suggests the above quoted recitation of amended Claim 1.

Therefore, for at least the above reasons, applicant submits that Claim 1, as amended, is allowable under 35 U.S.C. § 103 over Thrall in view of Cheung. Applicant respectfully requests that the rejection of Claim 1 under 35 U.S.C. § 103 be withdrawn.

B. Independent Claims 13 and 24

Applicant respectfully submits that Claims 13 and 24 are allowable at least for reasons including some of those discussed above in connection with Claim 1. For example, amended Claim 13 recites “determining whether the score exceeds calculated scores relating the search term to other items for which links appear in the search results for previously submitted queries” and “if the score is determined to exceed the calculated scores, requesting an advertisement for the item to be placed on a first page of search results to be provided to said consumer computer system in response to the received search query, the advertisement for the item being distinct from the search results to be provided to said consumer computer system in response to the received search query.”

Amended Claim 24 recites “means for determining whether the score exceeds calculated scores relating the search term to other items for which links appear in the search results for previously submitted queries,” and “means for requesting an advertisement for the item to be placed on a first page of search results to be provided to said consumer computer system in response to the received search query, the advertisement for the item being distinct from search results to be provided to said consumer computer system in response to the received search query.” Thus, at least for some of the reasons discussed above in regard to Claim 1, Claims 13 and 24 are submitted to be allowable over Thrall and Cheung.

C. Dependent Claims 2, 4, 5, 9-12, 14-18, 20, and 25-31

Claims 2, 4, 5, and 9-12 depend from Claim 1, Claims 14-18 and 20 depend from Claim 13, and Claims 25-31 depend from Claim 24, which are submitted to be allowable. Accordingly, applicant respectfully submits that Claims 2, 4, 5, 9-12, 14-18, 20, and 25-31 are allowable at least for depending from allowable claims.

Applicant additionally submits that at least some of the claims independently recite patentable subject matter. For example, Claims 11 and 12 recite the features (“the information sources include content not available through the Internet” and “the content is the text of a book”) that the Office Action did not specifically address in the rejection of claims. In the absence of such rejections, Claims 11 and 12 are submitted to be allowable under 35 U.S.C. § 102 over Thrall and Cheung. for at least these additional reasons.

IV. Amendments To The Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, applicant does not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a

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later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that applicant has made any disclaimers or disavowals of any subject matter supported by the present disclosure.

CONCLUSION

In view of the foregoing, applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: 6/7/10



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